

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Y. TOM TANG, NEIL C. CORLEY,
GINA A. GORGONE, KARL J. GUEGLER, and MARIAH R. BAUGHN

Appeal No. 2005-0230
Application No. 09/830,914

ORDER UNDER 37 CFR § 41.50(d)

Before WILLIAM F. SMITH, ADAMS and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

ORDER UNDER 37 CFR § 41.50(d)

Under the provisions of 37 CFR § 41.50(d),¹ we require Appellants to address
the following matters:

First, we invite attention to commonly assigned Application No. 09/078,402
where, according to Patent and Trademark Office (PTO) records, the applicants filed a
Notice of Appeal from the examiner's final rejection on June 25, 2001.² After a briefing
stage, another Merits Panel of the Board handed down its decision in the '402

¹ "The Board may order appellant to additionally brief any matter that the Board considers to be of
assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-
extendable time period within which to respond to such an order." 37 CFR § 41.50(d).

² The named inventors in the instant application are Y. Tom Tang, Neil C. Corley, Gina A. Gorgone, Karl
J. Guegler, and Mariah R. Baughn. In Application No. 09/078,402, the inventors are Jennifer Hillman,
Neil C. Corley, Karl J. Guegler, Chandra Patterson and Mariah Baughn. The applications are commonly
assigned.

application, affirming the examiner's final rejection of claims 3, 6, 7, 9-12, and 19-24 (Appeal No. 2003-1115, BPAI 2004).

We think it clear that Appeal No. 2003-1115, in Application No. 09/078,402, bears close relationship to the instant appeal. In Appeal No. 2003-1115, the claims are drawn, inter alia, to an isolated polynucleotide encoding a polypeptide comprising an amino acid sequence selected from the group consisting of: SEQ ID NO:3; residues 31 through 40 of SEQ ID NO:3; and SEQ ID NO:5 (claims 3, 6, 7, 9, 10, and 21), host cells and methods of making the encoded proteins (claims 11 and 12). Included among the issues presented for appeal was whether the applicants' claims were supported by a disclosure of utility sufficient to satisfy 35 U.S.C. § 101.

In Appeal No. 2003-1115, Appellants asserted that "the claimed invention ha[d] numerous practical, beneficial uses in toxicology testing, drug development, and the diagnosis of diseases..., none of which requires knowledge of how the polypeptide coded for by the polynucleotide actually functions." Decision, page 12. In addition, Appellants argued that the claimed polynucleotides are useful in, among other things, "gene and protein expression monitoring applications." Id. Appellants relied on the declaration of Dr. Tod Bedilion to support their argument that the claimed polynucleotides have patentable utility because they can be used to monitor gene expression. Further, Appellants asserted that the claimed polynucleotides encode proteins which "are in the class of 'apoptosis-associated proteins.'" Id., at page 19. In this regard, Appellants asserted "[i]n order to demonstrate utility by membership in a class, the law requires only that the class not contain a substantial number of useless

members.... That is true regardless of how the claimed invention ultimately is used and whether or not the members of the class possess one utility or many.” Id.

The previous Merits Panel reviewed governing principles of law; the Bedilion Declaration; and addressed and rejected the applicants’ arguments, concluding that “[a]ppellants’ disclosure in th[at] case does not provide a specific benefit in currently available form, and therefore lacks the substantial utility required by 35 U.S.C. § 101.” Decision, page 28. Accordingly, the rejection of all claims under 35 U.S.C. § 101 in Application No. 09/078,402, was affirmed.

Like the claims in Application No. 09/078,402, the claims in this appeal are drawn to isolated polynucleotides (claims 23-26, 30 and 31), a cell transformed with a polynucleotide of claim 26 (claim 27), and a method of producing a polypeptide encoded by the polynucleotide (claims 28 and 29). All of the appealed claims stand rejected under 35 U.S.C. § 101 and § 112, first paragraph, because “the claimed invention is not supported by either a credible, specific and substantial asserted utility, or a well established utility.” Answer, pages 3 and 4.

The Appeal Brief in this appeal includes essentially the same line of argument addressed by the previous Merits Panel in Appeal No. 2003-1115 (Appeal Brief, section (8)). For example, Appellants argue “the claimed invention has numerous practical, beneficial uses in toxicology testing, drug development, and the diagnosis of disease, none of which requires knowledge of how the polypeptide coded for by the polynucleotide actually functions” (id., bridging paragraph, page 5). Appellants rely on the Bedilion Declaration to support their assertion that the claimed invention has use in gene and protein expression monitoring applications. Id. pages 5, and 8-11. In

addition, in support of their assertion (Brief, page 17), "the claimed polynucleotide encodes a polypeptide in the myosin family", Appellants assert "[i]n order to demonstrate utility by membership in a class, the law requires only that the class not contain a substantial number of useless members.... That is true regardless of how the claimed invention ultimately is used and whether or not the members of the class possess one utility or many." Id., pages 17-18.

On these facts, we require that Appellants explain why we should address these arguments anew in this case. Since these same issues have been raised previously in Appeal No. 2003-1115, why would the previous Panel's treatment of these issues not be dispositive here? In particular, why should the facts and arguments set forth in Appellants' Appeal Brief lead to a different conclusion than that reached by another Panel in Appeal No. 2003-1115 rejecting the same line of argument? We note in passing that the Appellants did not request rehearing on the same record within two months from the date of the decision in Appeal No. 2003-1115. Rather, according to PTO records, the application was abandoned.

Second, Appellants state that "[t]here is no dispute that the claimed invention is in fact a useful tool in cDNA microarrays used to perform gene expression analysis." Brief, page 8. However, the assertion that "[t]here is no dispute that the claimed invention is in fact a useful tool" appears to be incorrect. See, e.g., Answer, page 13, wherein the examiner states "[a]ppellants assert that it cannot be disputed that the claimed polynucleotide is a useful tool in cDNA microarrays. ... Appellants' arguments have been fully considered but are not deemed to be persuasive." Accordingly, on this record, it

appears that there is a dispute whether the claimed invention is a useful tool in cDNA microarrays.

Explanation or clarification of this apparent discrepancy is required.

Third, according to Appellants "[l]iterature reviews published shortly after the filing of the ...[instant] application describing the state of the art further confirm the claimed invention's utility." Brief, page 11. In this regard, Appellants cite references authored by Rockett et al., Steiner et al., and Nuwaysir et al. having publication dates in 1999, 2000, and 1999, respectively (id., pages 11-13). We note that the instant application claims priority to provisional Application No. 60/172,248 filed November 5, 1998.

Explanation is required how the cited references would provide evidence that, as of the effective filing date of the present application, those of skill in the art would have recognized the asserted utilities as well-established.

Fourth, based on our review of the image file wrapper, we do not find any indication in the record that Appellants have submitted into the record:

- the April 9, 2000, article published by the Bloomberg News Service (Appeal Brief, pages 12-13);
- the February 10, 2000, article in the Wall Street Journal (id., page 13); or
- evidence reflecting the work by C.V. Therapeutics (id., page 12).³

Accordingly, explanation or clarification is required respecting just what evidence is of record which would support Appellants' argument in the Appeal Brief, pages 13-14.

³ Generally speaking, the submission of evidence after a case has been appealed would be considered untimely. As stated in the then existing 37 CFR § 1.195 (2003), "[a]ffidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient

Conclusion

In conclusion, we require Appellants to address the foregoing matters "deemed appropriate for a reasoned decision on the pending appeal." 37 CFR § 41.50(d)(2003). We caution, however, that this is not an invitation to expand on points raised in the Appeal Brief or to rehash arguments already set forth in the Appeal Brief. This is not an invitation to raise arguments or issues on appeal, or to collaterally attack the decision in Appeal No. 2003-1115. See 37 CFR § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown"). Appellants' response should be confined to the matters outlined above.

Time Period For Response

A period of one month from the date of this order is set for Appellants' response. This time is non-extendable.

Failure to respond in a timely manner will result in dismissal of the appeal.

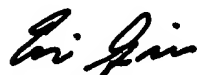
37 CFR § 41.50(d)


William F. Smith

Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge

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